

US Serial No. 10/597350
Page 5 of 10

Remarks:

Regarding the rejection of claims 1, 3-5, 8-16, 18, 19, 20-22 under 35 USC 103(a) over US 6124253 to Vinci et al (hereinafter "Vinci"):

The applicant respectfully traverses the Examiner's rejection of the claims with regard to the Vinci reference.

Turning to the Vinci reference, although the Examiner contends that the presently claimed invention would be arrived at only by trivial modifications of the Vinci reference, the applicant strongly disagrees.

The Vinci composition is directed to a metal cleaning composition which is to be used without agitation to avoid the deleterious effects of foaming at relatively low temperatures, e.g. ambient temperature. More specifically Vinci provides:

"An alkaline, aqueous metal-cleaning composition capable of effectively removing industrial-type soil contaminants from a metal surface at temperatures as low as ambient temperature and in the absence of substantial agitation contains (A) an active-ingredient portion containing (1) an alkalinity-providing component, and (2) a surfactant mixture containing: (a) at least one first non-ionic, ethoxylated linear primary alcohol surfactant having a hydrophobic carbon chain length of from 9 to 11 carbon atoms and being ethoxylated with (i) an average of 2.5 moles of ethylene oxide or (ii) an average of 5.0 moles of ethylene oxide; and (b) at least one second non-ionic, ethoxylated linear primary alcohol surfactant having a hydrophobic carbon chain length of from 9 to 11 carbon atoms and being ethoxylated with an average of 6.0 moles of ethylene oxide; and (B) an aqueous portion."

First, the applicant points out that *nowhere* in the Vinci reference is there *any discussion* as to the provision of a "self motile" type composition which is included in the applicant's claims as nowhere does Vinci provide any specific teaching or suggestion as

US Serial No. 10/597350
Page 6 of 10

to the necessity of, or the desirability of, providing a composition such as the applicant now claims in presently amended claim 1. Thus, Vinci fails in providing any suggestion or motivation as to provide the types of compositions as applicant now presently claims.

Second, while the Examiner suggests that the currently claimed compositions would be obvious as being the result of "routine experimentation" the applicant strongly traverses the Examiner's position. The applicant takes the position that there is *nothing* in the Vinci reference which would (i) suggest any desirability of selected specific constituents, in specific proportions such that they are present in a chemical equilibrium at or adjacent to a phase boundary such that (ii) loss of 1% or less of one of 1-alkyl-2-pyrrolidone, hydrocarbon, or water would cause a change in the total phases present and induce motility of the composition. Indeed, by routine inspection it is evident that the essential constituents of Vinci are not the same essential constituents required of applicant's claimed invention.

Third, the applicant strongly traverses the Examiner's following assertions in the outstanding *Office Action*:

With regard to exhibition of self induced motility, after application of this composition on a surface, due to specific variations in concentrations of three-components responsible for equilibrium phase diagram, it is noteworthy to indicate the following. It is well known in the art that the Gibbs-Marangoni effect (e.g. tears of wine) is caused by factors such as concentration gradient, temperature gradient, surface tension gradient, density, or a cumulative and simultaneous combination of these

US Serial No. 10/597350
Page 7 of 10

effects. The term self induced motility (which is more relevant in study of micro-organisms) is also a direct consequence of properties such as surface tension and vapor pressure in liquids. Any change in concentrations of components (e.g. solubility change due to salting out effect caused by electrolytes,...etc) would simply disturb an already established equilibrium of a given phase diagram, which in turn would lend itself to a new equilibrium position and new number of phases. Thus differences in density and vapor pressure are bound to manifest themselves by creating an observable behavior such as self-induced motility.

It is the applicant's view that the Examiner's rejection of the claims is in no small part based on a "hindsight reconstruction" of the applicant's invention which is based on a retrospective assemblage of the applicant's claimed invention wherein there lacks an appropriate teaching or suggestion. Such is believed to be inappropriate. In *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

It is the applicant's view that the prior art documents cited by the Examiner fail to meet the proper burden of proof, and that the presently presented claims should be allowed. The Vinci reference is *completely silent* as to the production of any formulation which would exhibit features of the presently claimed composition, viz., "... exhibits self-induced motility when applied to a household substrate..." thus, absent the exercise of impermissible hindsight reconstruction it is not seen how a skilled artisan reading Vinci would arrive at applicant's currently claimed invention. Furthermore, as Vinci fails to discuss any self-motile behavior or "Marangoni effect", Vinci provides no incentive to produce such compositions which exhibit such a behavior, as Vinci also fails to realize

US Serial No. 10/597350
Page 8 of 10

improved technical benefits which may be realized from such compositions. As applicant states at pages 6-7 of their (PCT application text) application:

Without wishing to be bound by theory, it is thought
30 that the Marangoni effect may give rise to cleaning
benefits exhibited by compositions of the invention.
Compositions exhibiting the Marangoni effect may exhibit a
tendency to "creep" into small spaces. Evaporation of a
compound may lead to changes in surface tension and to
surface motility, causing the composition to move, for
example into and then out of a crack, drawing soils with
it. The use of amphiphiles such as 1-alkyl-2-pyrrolidone
5 may assist separation of dirt from a substrate.
Amphiphiles generally do not promote adhesion with a
surface but they may wet well. Thus amphiphile-containing
compositions which exhibit the Marangoni effect may move
into small interstices or may move between a surface and a
10 soil deposit, "lifting" the latter.

In view of the foregoing, applicant maintains their strong traverse of the Examiner's rejection and requests reconsideration and withdrawal of the same.

Regarding the rejection of claims 7 and 17 under 35 USC 103(a) in view of US 6124253 to Vinci, further in view of US 6150318 to Silvester:

The applicant traverses the Examiner's rejection of claims 7 and 17 in view of the combined Vinci and Silvester references.

The Examiner relies upon the Silvester reference to address the further limitations of claims 7 and 17, as respectively Vinci does not discuss a "package" or "bleach" in his reference. With regard to packaging, the applicant concedes that packaging for hard surface treatment compositions is *per se*, indeed old in the art however the applicant does

US Serial No. 10/597350
Page 9 of 10

not concede that the subject matter of presently amended claim 1 is diminished in any way by packaging the same in a container, as the novel and inventive nature of the currently claimed composition is itself patentable, and packaging the same in conventional flask or other container does not diminish the patentability of the composition of claim 1. As noted above and discussed with reference to the Vinci reference, Vinci fails to render the applicant's claimed invention as being "obvious" and thus, accordingly, dependent claim 7 should be considered as unobvious as being based on the patentable subject matter of independent claim 1. Similarly, with regard to claim 17, as the subject matter of the claim is dependent from claim 1 which is itself believed to be patentable, itself.

In addition to the above, the applicant also points out that the Silvester reference fails to teach or suggest in any way suggest any desirability of selecting 1-alkyl-2-pyrrolidone, hydrocarbon, or water and provide these in specific proportions such that they are present in a chemical equilibrium at or adjacent to a phase boundary such that loss of 1% or less of one of 1-alkyl-2-pyrrolidone, hydrocarbon, or water would cause a change in the total phases present and induce motility of the composition. Silvester fails to identify these constituents, and thus cannot be held to suggest the desirability of bleach to a composition which requires such a chemical equilibrium between 1-alkyl-2-pyrrolidone, hydrocarbon, and water.

Accordingly, reconsideration of the propriety of the outstanding rejection of the specification, and of all of the claims is requested.

CONDITIONAL AUTHORIZATION FOR FEES

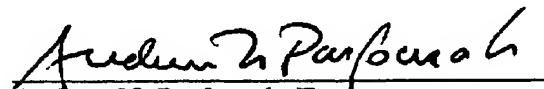
Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

US Serial No. 10/597350
Page 10 of 10

PETITION FOR A ONE-MONTH EXTENSION OF TIME

The applicants respectfully petition for a two-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

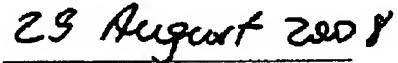
Respectfully Submitted;



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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and any indicated enclosures thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-273-8300 on the date shown below:



Andrew N. Parfomak



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